



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

24 APR 2007

KEVIN D. McCARTHY
ROACH BROWN McCARTHY & GRUBER, P.C.
1620 LIBERTY BUILDING
BUFFALO, NY 14202

In re Application of BRON et al :
U.S. Application No.: 10/588,398 :
PCT Application No.: PCT/IL2005/000554 :
Int. Filing Date: 30 May 2005 : COMMUNICATION
Priority Date Claimed: 10 June 2004 :
Attorney Docket No.: 0-06-172 :
For: SCORCH PREVENTION IN FLEXIBLE
POLYURETHANE FOAMS :

This is in response to applicant's correspondence filed 16 March 2007.

BACKGROUND

On 30 May 2005, applicant filed international application PCT/IL2005/000554, which claimed priority of an earlier Israel application filed 10 June 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 22 December 2005. The thirty-month period for paying the basic national fee in the United States expired on 10 December 2006.

On 03 August 2006, applicant filed application papers in the USPTO including, *inter alia*, a Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Submission Under 35 U.S.C. 371 (Form PTO-1390).

On 20 February 2007, the USPTO mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905).

On 16 March 2007, applicant filed the present response.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official USPTO Notice published in the Official Gazette at 1077 OG 13

entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states in relevant part:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111. . . .

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111. (Emphasis added.)

Although Form PTO-1390 filed 03 August 2006 identified the application as a national stage application being filed under 35 U.S.C. 371, Form PTO-1390 is marked with the statement, "This application is a continuation-in-part of PCT application no. PCT/IL2005/000554, filed on May 30, 2005." Furthermore, the 03 August 2006 contained a preliminary amendment cover page which states, "Applicant acknowledges on the transmittal sheet that this application is a continuation-in-part of PCT application number PCT/IL2005/000554, filed on May 30, 2005."¹ Such statements are inconsistent with and would have contradicted any desire expressed in any papers that might have been filed to enter the national stage of the PCT under 35 U.S.C. 371. See MPEP 1893.03(a), which states, "A conflicting instruction will be present, for example, where applicant includes in the initial submission under 35 U.S.C. 371, . . . a benefit claim under 35 U.S.C. 120 to the international application." Because the 03 August 2006 submission was not clearly and unambiguously identified as a filing under 35 U.S.C. 371, the submission should have been treated as a submission under 35 U.S.C. 111(a).

CONCLUSION

The Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 20 February 2007 is hereby VACATED.

This application is being forwarded to the Office of Initial Patent Examination (OIPE) for processing as an application filed under 35 U.S.C. 111(a).

Bryan Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

¹ Applicant is advised that the requirements of 37 CFR 1.78(a)(2) do not appear to have been met.